

R E M A R K S

Attention is respectfully directed to the fact that a claim for the benefit of priority based on the foreign priority papers filed in parent Application No. 09/589,792 was set forth on p. 2 of the transmittal letter filed September 12, 2003, concurrently with the filing of the above-identified application.

In response to the requirement for a drawing, submitted herewith is a drawing (labeled "New Sheet"). This drawing is believed to be fully and expressly supported by the disclosure of the application as filed, at the portion of the specification cited in the discussion under the heading "Drawing Amendment" on p. 3 of this Amendment; therefore, it does not introduce new matter.

The specification has been amended as required by the Examiner, to provide a new title which is clearly indicative of the invention to which the claims are directed, and to indicate the current (abandoned) status of the parent application identified in the cross-reference to related applications. In addition, a Brief Description of the (new) drawing has been introduced to the specification ahead of the Description of the Preferred Embodiments; this brief description, again, does not introduce new matter, because it is expressly supported by the disclosure of the specification as filed, at p. 6, last line, to p. 7, line 1.

The documents cited on p. 2 of the previously filed Information Disclosure Statement do not appear to be associated with any U.S. patents, so far as the undersigned can determine from the search facility on the USPTO website.

Claims 9 and 10 are in the application. No claim has been allowed.

In response to the rejection of the claims under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement, applicant respectfully submits that the claim recital "formatting the medium at a recording power which is

lower than the recording power determined as a result of the power calibration" is clearly and expressly supported by written description in the specification as originally filed.

For example, at pp. 3-4, the specification describes a "recording power determined as a result of the power calibration." This recording power is the "average recording power" obtained by "conducting power calibration a plurality of times to obtain a plurality of recording powers corresponding to the number of the power calibrations conducted" and "calculating an average recording power from the plurality of recording powers obtained." The "average recording power" thus described is plainly "a recording power" as recited at line 4 of claim 9, since it is determined as a result of a power calibration performed by a drive.

At p. 4, lines 3-7, the specification describes the steps of multiplying this average recording power (i.e., as explained above, "a recording power" as recited at line 4 of claim 9) "by a predetermined coefficient to obtain a recording power for formatting," and "formatting a phase-change optical disk in accordance with the recording power for formatting."

Then, at p. 4, lines 13-14, the specification sets forth that "In the above method of the present invention, the predetermined coefficient may be 1 or less" (emphasis added).

This teaching of the specification may be expressed by the following equation (1):

$$PF = Q \times PA \quad (1)$$

wherein

PF is the recording power for formatting,

Q is the predetermined coefficient, and

PA is the "average recording power," i.e., the "recording power determined as a result of the power calibration" recited in claim 9, lines 7-8.

As will be apparent, the specification expressly discloses $Q < 1$ (the predetermined coefficient may be less than 1). From equation (1) above, when $Q < 1$, $PF < PA$, i.e., the recording power

for formatting is less than (lower than) "the recording power determined as a result of the power calibration."

See also the disclosure of the original specification at p. 5, lines 17 - 19 ("According to the present invention, the recording power at the time of formatting can be set so as to be lower than the power with which the drive records"), and the further description at p. 9, lines 5 - 12.

Thus, claim 9 is properly supported by the original written description in the specification, satisfying the requirement of §112, first paragraph. Since claim 10 has been rejected under §112 only because it "falls" with claim 9, it is submitted that claim 10 satisfies the "written description" requirement as well.

Turning to the rejection of the claims under 35 U.S.C. §101 as lacking patentable utility, applicant submits that this ground of rejection is predicated on error, viz., the assertion that "if the established laser power is less than a universal lower limit, as required by the claim, nothing could be written to the [disk]" (Office Action, p. 3, last paragraph).

In actuality, claim 9 does not require that the formatting power be "less than a universal lower limit" below which nothing can be written to the disk. What claim 9 specifies is that the formatting power be lower than a recording power determined as a result of a power calibration performed by a drive. The latter recording power is not a power below which nothing can be written to the disk; illustratively, the specification describes performing the power calibration, as a result of which this "recording power" is determined, by a specified procedure well-known in the art (see p. 7, line 22 - p. 8, line 7). As the specification explicitly teaches (p. 5, last paragraph), "the recording power at the time of formatting can be set so as to be lower than the power with which the drive records."

That is to say, the disk can be formatted with a recording power lower than the recording power determined as the result of the power calibration performed by a drive. It follows that the method claimed in claim 9, and its product as claimed in claim 10,

do not lack utility, but instead, provide a usefully formatted disk.

For the foregoing reasons, it is believed that this application is now in condition for allowance. Favorable action thereon is accordingly courteously requested.

Respectfully,

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I hereby certify that this paper is being deposited this date with the U.S. Postal Service as first class mail addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Date JANUARY 31, 2006

DRAWING AMENDMENT

Please add the attached new sheet of drawing, which is labelled "NEW SHEET" and contains a single Figure. No drawing was present in the application as filed.

The showing of the Figure on the attached new sheet of drawing is fully and expressly supported by the disclosure of the original specification, at p. 6, line 23, to p. 7, line 10, which describes every element shown in the drawing.